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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/878,720 | 06/11/2001 | Martin James Walker | B-4209 618873-3 | 2069 |
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| LADAS & PARRY 5670 WILSHIRE BOULEVARD, SUITE 2100 LOS ANGELES, CA 90036-5679 | | | EXAMINER CHOI, PETER H | |
| | | | ART UNIT 3623 | PAPER NUMBER |

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/878,720

Applicant(s)

WALKER ET AL.

Examiner

Peter Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/11/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-40 are pending in the application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
4. Claims 1-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As per claims 1,5, 18, 26, and 33, it is not understood how the establishment of a business "innovation park" would enable the development of business proposals. It seems that a human would actually perform all the tasks associated, while the park itself merely transmits data and information back and forth between users and consultants located inside and outside of the park. Albeit conducted within the specialized zones and areas of the innovation park, nonetheless, a human is responsible for all aspects of developing business proposals. It is not understood how the environment itself is not conducive to developing business proposals. The recited steps are subjectively performed by a human. The applicant's specification does not disclose any quantifiable or otherwise repeatable means or methodology for producing consistent results for the steps of experiencing technologies, simulating relevant scenarios, envisioning and conceptually exploring business proposals, examining the business case, or evolving the execution plan of the business proposal for realization. These steps are all carried out by a human (or a group of humans). The metes and bounds of these determinations are unclear because the results of these determinations are based on the complete subjectivity of a human user. The specification does not provide adequate written disclosure to enable an artisan of ordinary skill in the art to make and/or use the invention as intended by the Applicant since the invention could be utilized differently by each human user in light of differences in subjectivity among humans.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-14 are rendered vague and indefinite. The claims are directed towards a park. A park is merely a physical location, which does not expressly impart any structure. Even though the claimed part is arranged as in a theme park and divided into a plurality of distinct zones of interaction, the park does not comprises these elements. In other words, these elements are just situated within the park and are not clearly integrated as a conglomerated system.

Claims 15-17 are rendered vague and indefinite. The method claims are directed to park claim 5. As such, claims must be directed to a single statutory class of invention.

Claims 18-40 are rendered vague and indefinite. The claims are directed to a system and method comprising various zones. A zone is merely a specialized area within a centralized location, which does not expressly impart any structure. Even though each of the zones "includes" an information technology infrastructure to collect, collate, and present data and the ability to operate hand-held mobile devices that

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communicate with said infrastructure, the claimed zones do not comprise these elements. In other words, these elements are just situated within the zones and are not clearly integrated as a conglomerated system.

As per claims 1-40, it seems that a human would actually carry out the analysis and other steps associated with developing a business plan, especially the steps of experiencing technology, envisioning new business proposals, examining the business case, and evolving an execution plan for realizing the business proposal. The human users would decide what information should be transmitted amongst other users (project team members, consultants, and outsiders), where an interaction of thoughts and ideas occur (formally, informally, location, etc.), and when to progress from zone to zone (reflecting the stage of business proposal development). The metes and bounds of these determinations are unclear because they are entirely based on the complete subjectivity of a human user, further rendering the claims vague and indefinite.

Because claims 1-40 are so indefinite, no art rejection is warranted, as substantial guesswork would be involved in determining the scope and content of these claims. See *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962); *Ex parte Brummer*, 12 USPQ 2d, 1653, 1655 (BdPatApp&Int 1989); and also *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). Prior art pertinent to the disclosed invention is nevertheless cited and applicants are reminded they must consider all cited art under Rule 111(c) when amending the claims to conform with 35 U.S.C. 112.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject

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matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Applicant is directed to 35 U.S.C 101, which states that any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent. Claims 1-14 are direct to a park, a physical location in which activities are performed.

While claims 1-40 produce what is likely a useful result, due to the inability of an artisan skilled in the art to reproduce the results consistently due to the subjective nature of the recited steps (as discussed in the rejections under 35 U.S.C § 112, 1st and 2nd paragraphs above), the concreteness and tangibility of claims 1-40 are placed into doubt.

Furthermore, claims 1-40 merely recite a nominal use of technology since technology is only used to transmit data back and forth between users within the site. Technology does not have a substantial effect on the practice of the site or in the development of business proposals. The depth of the role and purpose of the claimed "future world zone" to provide leading edge technologies is unclear. On page 6 of the specification, it is detailed that within "Future World", the user is enabled to experience guided tours of future scenarios, view reference materials (books, Internet, etc.), and

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determine current and possible connections to the Internet. From the descriptions of these functions, it is unclear how they impact the development of a business proposal from an initial idea to an execution plan. Therefore, claims 1-40 are deemed to be non-statutory for failure to produce a concrete and tangible result as well as for failure to produce a concrete and tangible result as well as for failure to sufficiently incorporate the technological arts.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

"The Original EPCOT" teaches Walt Disney's announcement in November 1965 to build a model community, EPCOT (Experimental Prototype Community of Tomorrow). EPCOT would employ the "hub" principle employed to success at Disneyland, featuring a centralized area (hotel) at its center.

The Wikipedia entry for Epcot teaches the historical roots of the Epcot theme park located at the Walt Disney World Resort in Florida. It discloses that Walt Disney's original vision of EPCOT was for a circular community with business and commercial areas at its center, community buildings and schools and recreational complexes around it, and residential areas along the perimeter. The Epcot theme park was

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intended to represent the cutting edge of technology, and comprises of two sections: Future World and World Showcase. Future World consists of a variety of pavilions that explore innovative aspects and applications of technology, including a plurality of guided tours and educational presentations.

Archived (between August 1999 and May 2000) webpages of Mickey-Mouse.com's "Disney World – Epcot" teaches the many sections of Epcot Park. Firstly, the Park is split into two areas – Future World and World Showcase. Future World is then further divided into nine pavilions, and World Showcase into eleven international pavilions. Most of the pavilions in Future World feature educational presentations and guided tours of technological innovations.

Tao Yungang's "Shanghai Opens High-Tech Park" teaches that, on April 24, 2000, the Zhangjiang High-Technology Park was opened as a technological innovation park. Opened in March 2000, the Shanghai Zhangjiang Technological Innovation Park is devoted to high-tech research, and both central and local governments hope to take advantage of the park's infrastructure to develop Chinese patents.

Businessline's "India: Rural Technology Parks for N-E on the Anvil" teaches that rural technology parks (RTP) are being established in each of the seven North-East States of India during fiscal year 2000-2001. The parks are defined to focus on region-

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specific technologies, serving as technology demonstration centers that will also counsel village entrepreneurs about appropriate technology areas to take up.

Renee Gotcher and Laura Kujubu's "The Network Comes Home" teaches that integrated home networks that connect consumer devices and "smart" appliances with PCs, the Internet, phone services, and home security system are on the horizon. It teaches that new standards, access devices, software, and services are all aimed at seamless integration with future applications and technologies while providing the functionality needed for today's world. Access devices and satellite services will enable two-way wireless networking between an array of consumer (hand-held) devices with surrounding information technology infrastructures (Internet, PCs, phone services, etc). Wireless technology offers cheaper infrastructures, decreased costs, and increased global coverage, and will be integrated to encompass voice, data, and video communications. Satellite services will provide a range of services, including Internet access, video access, and telephony services and worldwide two-way communications. Home networks will be able to add video to voice communications, adding voice and video to data communications, providing on-demand entertainment, and expending Internet connectivity to almost any household device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Choi whose telephone number is (571) 272 6971. The examiner can normally be reached on M-F 8-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PC

September 16, 2005

Peter Choi
Examiner
Art Unit 3623

Susanna Diaz
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